

REMARKS/ARGUMENTS

Claims 23-41 are active in the application subsequent to entry of this Amendment.

In order to facilitate examination and reduce issues, composition claims 1-11 and 15-18 have been canceled and rewritten as claims directed to a method of potentiating the activity of H₂O₂-producing lactic acid bacteria by combining component A with component B. The primary focus of the present invention is the discovery that certain lactic acid bacteria potentiate the activity of peroxide-producing lactic acid bacteria and it is this recognition upon which the present invention is based. These procedures are featured in new claims 23-37.

Claims 19 through 22 have been replaced with revised claims 38-41 directed to methods of prophylaxis or treating infections or inflammatory conditions. It is submitted that the new claims presented above properly and clearly define the invention and are compliant with 35 USC §112, second paragraph. Favorable consideration of these claims is requested.

In the Official Action of June 3, 2003 (Paper No. 11) claims 1-11 and 15-22 were rejected as being unpatentable over Vesely et al U.S. 6,277,370 considered in combination with Ehret U.S. 6,159,724. The primary reference is directed to preparations and compositions for the treatment of vaginosis and vaginitis while the secondary reference is directed to making bread. Neither reference is concerned with the concept of potentiating the activity of peroxide-producing lactic acid bacteria nor suggest mixing or combining peroxide-producing lactic acid bacteria with arginine-utilizing lactic acid bacteria. Applicant completely disagrees with the examiner's attempt to combine these references for neither provides a suggestion to make the combination much less combining or mixing an arginine-utilizing lactic acid bacteria with a peroxide-producing lactic acid bacteria.

The U.S. Court of Appeals for the Federal Circuit has stated that "[t]he mere fact that the prior art may be modified in the manner suggested by the examiner does not

make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). Although this statement is couched in terms of modifying the prior art, in May of this year the Board of Appeals and Interferences, in a non-precedential decision (67 USPQ2d 1633 at 1635) held that the mere fact that teachings found in the prior art could be combined as proposed by an examiner does not make the combination obvious "absent some teaching, suggestion or incentive supporting the combination." *Carella*, 804 F.2d at 140, 231 USPQ at 647 (citing *ACS Hosp. Syss., Inc.*, 732 F.2d at 1577, 221 USPQ at 933).

Even assuming *arguendo* the two documents may be combined (applicant does not agree to this), there still is no reasonable assurance in the art that peroxide-producing lactic acid bacteria could be potentiated in activity by employing an arginine-utilizing lactic acid bacteria – in other words, there is no expectation that the combination of disclosures would result in the method defined by applicant's claims either in potentiating the activity of peroxide-producing lactic acid bacteria or for providing an effective way of preventing or treating infections or inflammatory conditions as featured in claims 38-41.

Applicant is puzzled by the examiner's comment "Vesely certainly does not teach against selecting *L. brevis* which utilizes arginine as disclosed by Ehret" (page 7, lines 12-13). The point that should be noted is that Vesely "is silent with regard to *L. brevis* utilizing arginine" as the examiner also stated on page 7, at line 8 of the current Action. One must not lose sight of the fact that neither document discloses the desirability of combining one with the other, hence motivation has not been established but to argue that the primary reference "does not teach against selecting ..." is not the standard for determining patentability under 35 USC §103(a).

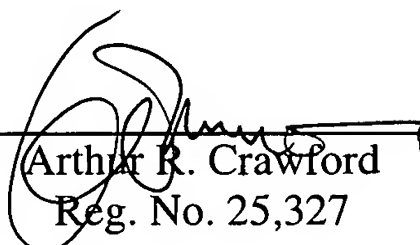
For the above reasons it is respectfully submitted that claims 23-41 define patentable subject matter. Reconsideration and allowance are solicited.

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Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____


Arthur R. Crawford
Reg. No. 25,327

29009

ARC:eaw
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100